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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,127	04/05/2006	Roy Garvin	18880-002US1	2941

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EXAMINER

BASS, DIRK R

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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06/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,127	Applicant(s) GARVIN ET AL.	
	Examiner DIRK BASS	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/26/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendments filed March 25, 2009 are acknowledged. Claims 1, 16, and 19 are amended. Claims 1-19 are pending in the application and are further considered on the merits.

Response to Amendment

2. In light of the amendments to the specification, the objections to the specification have been withdrawn. In light of the amendment to claims 1 and 16, the examiner modifies the rejections over the prior art. In light of the amendment to claim 19, the examiner withdraws the 35 U.S.C. 101 and 112 second paragraph rejections and modifies the rejections over the prior art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman, US 5225165 (Perlman).

Regarding claims 1 and 16, Perlman ('165) discloses a microtube comprising;

- a. A container having an open end defining an opening for receiving materials to be contained (“upper opening 15”, fig. 5), and a closed end (see bottom of “container 11”, fig. 1); and
- a. A lid adapted to make closing contact with the opening of the container (“lid 14”, fig. 1-5), wherein the lid is provided with a flange extending outwardly therefrom (“lid extension 24”, fig. 1-5), and arranged to move towards the closed end of the container upon application of a mechanical force to a surface of the flange so as to remove the closing contact, whereby the container is opened (col. 2, l. 30-39).

While Perlman fails to explicitly disclose a microtube wherein the flange is positioned within the half of the lid proximal to the hinge, it would have been obvious to one having ordinary skill in the art to relocate the flange of Perlman on a lid, since it has been held that rearranging parts of an invention involves only routine skill in the art (see MPEP 2144.02, Section VI, Part C).

Regarding claims 2-3, Perlman ('165) discloses a microtube which is a microcentrifuge tube (col. 2, l. 20-25) suitable for holding relatively small volumes of material, wherein the relatively small volume of material is a volume up to 4 ml. It is implicit in Perlman ('165) that the claimed microcentrifuge tube is capable of holding volumes between .4 and 2 ml. as related to the general definition of a microcentrifuge tube given in the background of the invention (col. 1, l. 9-14).

Regarding claim 4, Perlman ('165) discloses a microtube which is a microcentrifuge tube (col. 2, l. 20-25).

Regarding claim 5, Perlman ('165) discloses a microtube wherein the lid is adapted to make a sealing contact with the opening of the container (col. 6, l. 7-14).

Regarding claim 6, Perlman ('165) discloses a microtube wherein the lid is connected to the container by a connecting means (see “lid hinge 16”, fig. 1-5).

Regarding claim 7, Perlman ('165) discloses a microtube wherein the connecting means provides for relative movement between the lid/flange and the container (fig. 5).

Regarding claim 8, Perlman ('165) discloses a microtube wherein the connecting means is a hinge (see “lid hinge 16”, fig. 1-5).

Regarding claim 9, Perlman ('165) discloses a microtube wherein the connecting means comprises a hinge which may be fixed to the upper perimeter wall of the container defining the opening and to the lower surface of the lid, and about which the lid/flange and container can move (see "lid hinge 16", fig. 5).

Regarding claim 10, Perlman ('165) discloses a microtube wherein the lid is adapted such that the flange extends outwardly from a position adjacent to or in axial alignment with the connection means (see "lid extension 24", fig. 5).

Regarding claim 11, Perlman ('165) discloses a microtube wherein the flange extends upwardly (see "lid extension 24", fig. 5).

Regarding claims 12-13, Perlman ('165) discloses a microtube which is constructed of a plastics material wherein the plastics material is laboratory grade injection molded plastic (see "virgin polypropylene or polyethylene", col. 5, l. 67 – col. 6, l. 4).

Regarding claim 14, Perlman ('165) discloses a microtube wherein the lid and flange parts of the tube are made as an integral part of the container (fig. 5).

Regarding claim 15, Perlman ('165) discloses a microtube wherein the flange is adapted for use as a handle (see "lid extension", col. 3, l. 49-52).

Regarding claim 17, Perlman ('165) discloses a storage system/vessel comprising one or more microtubes (col. 4, l. 67 – col. 5, l. 9 and col. 5, l. 65-66).

Regarding claim 18, Perlman ('165) discloses a storage system wherein the storage system/vessel is a rack, a reaction vessel, or a centrifuge (col. 4, l. 67 – col. 5, l. 9 and col. 5, l. 65-66).

Regarding claim 19, Perlman ('165) discloses a method of using a microtube for the storage of material, as reaction vessels, or in centrifugation (col. 4, l. 67 – col. 5, l. 9 and col. 5, l. 65-66).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 16, and 19 have been considered but are moot in view of the new ground(s) of rejection.

While applicants argue that Perlman does not teach the disclosed microtube, specifically a tube wherein the flange is positioned within the half of the lid proximal to the hinge, the limitation is a matter of obviousness in relation to the location of parts (see MPEP 2144.04, Section VI, Part C). The modified rejection over the prior art renders claims 1-19 obvious in view of Perlman.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIRK BASS whose telephone number is (571) 270-7370. The examiner can normally be reached on Mon - Fri (9am-4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/27/2009

/Yelena G. Gakh/
Primary Examiner, Art Unit 1797

/DRB/
Dirk R. Bass